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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,060	12/04/2003	Kelly Tidwell	5983P002	7669
8791	7590	06/01/2006	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			KIM, YOON YOUNG	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,060

Applicant(s)

TIDWELL, KELLY

Examiner

Yoon-Young Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>05/23/06</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the Amendment filed on March 17, 2006.

Drawings

1. The drawings were received on March 17, 2006. These drawings are accepted.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 8, 10-15, 17, 19, 22-25, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox, U.S. Patent No. 5,888,383 in view of Faria, U.S. Patent No. 5,066,391.

Regarding Claim 8, Cox discloses a reusable filter having an internally threaded first opening (#7) at one end thereof for threading onto a filter mount on an engine, at least one second opening (#9) adjacent the first opening, and a face seal (#15) circumscribing the first and second openings for sealing against a filter mount, and a filter element (#30) therein, comprising: a can-like body (#3); a tubular woven metal mesh filter element (Col. 3, Lines 52-54); a cap (#2) having the first (#7) and second (#9) openings therein, the second openings being distributed around the first opening; and a face seal (#15) on the cap; the cap being removeably assembleable to the can-like body (Fig. 1); the tubular woven metal mesh filter element fitting within the enclosure defined by the can-like body and the cap and being imposed

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in the oil flow path between the first and second openings. However Cox does not disclose the shape of the second openings. Faria discloses a reusable oil filter comprising annular arc segment openings (Fig. 1, #48) distributed around a first opening (#50). It would have been obvious to one of ordinary skill in the art to modify Cox with the element of Faria because they are both reusable oil filters. Furthermore, the annular arc segment shapes have no mechanical function and cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 73 USPQ 431 (1947). The openings of Cox are deemed to be a structure equivalent to the annular arc segment openings of the invention.

Regarding Claim 10, Cox discloses that the woven metal mesh filter element is pleated (Col. 5, Lines 32-34).

Regarding Claims 11 and 22, Cox discloses that the tubular woven metal mesh filter element has a closure member (Fig. 1, 32) permanently attached to a first end thereof, the tubular woven metal mesh filter element being assembleable in the reusable filter with a second end (#21) thereof facing the cap.

Regarding Claims 12 and 23, Cox discloses an o-ring (#18) sealing the second end of the tubular woven metal mesh filter element against an inner surface of the cap.

Regarding Claim 13, Faria discloses that the cap (#40) and can-like body (#20) screw together.

Regarding Claims 14 and 24, Faria discloses an o-ring seal (#44) between the cap and the can-like body.

Regarding Claims 15 and 25, Cox discloses that the face seal on the cap is an o-ring (Col. 3, Lines 25-28).

Regarding Claim 17, Cox discloses a bypass valve (#37) responsive to a predetermined pressure difference between the outer periphery and inner periphery of the filter element.

Regarding Claim 19, Cox discloses a reusable filter having an internally threaded first opening (#7) at one end thereof for threading onto a filter mount on an engine, at least one second opening (#9) adjacent the first opening, and a face seal (#15) circumscribing the first and second openings for sealing against a filter mount, and a filter element (#30) therein, comprising: a can-like body (#3); a tubular woven, pleated metal mesh filter element (Col. 5, Lines 32-34); a bypass valve (#37) responsive to a predetermined pressure difference between the outer periphery and inner periphery of the filter element; a cap (#2) having the first (#7) and second (#9) openings therein, the second openings being distributed around the first opening; and a face seal (#15) on the cap; the cap being removeably assembleable to the can-like body (Fig. 1); the tubular woven, pleated metal mesh filter element fitting within the enclosure defined by the can-like body and the cap and being imposed in the oil flow path between the first and second openings. However Cox does not disclose the shape of the second openings or screw threads on the cap and body. Faria discloses a reusable oil filter comprising annular arc segment openings (Fig. 1, #48) distributed around a first opening (#50) and the cap (#40) being assembled to the can-like body (#20) by screw threads. It would have been obvious to one of ordinary skill in the art to modify Cox with the element of Faria because they are both reusable oil filters. Furthermore, the annular arc segment shapes have no mechanical function and cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 73 USPQ 431 (1947). The openings of Cox are deemed to be a structure equivalent to the annular arc segment openings of the invention.

Regarding Claims 27 and 30, Cox discloses that the bypass valve (Fig. 2, #37) is mounted on a member (#14) positioned between an inner end of the can-like body (#3) and a first end of the tubular woven metal mesh filter element (#30).

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4. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Faria as applied to Claims 8 and 19 above, and further in view of Deibel et al., U.S. Patent No. 6,221,242 B1.

Regarding Claims 9 and 21, Cox in view of Faria does not disclose the material of the filter element. Deibel teaches a stainless steel woven metal filter element (Col. 6, Lines 34-37). It would have been obvious to one of ordinary skill in the art to modify Cox in view of Faria with the element of Deibel because they are reusable oil filters and because it is a material of manufacture common in the filter art.

5. Claims 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Faria as applied to Claims 8 and 19 above, and further in view of Tettman et al., U.S. Patent No. 5,679,244.

Regarding Claims 16 and 26, Cox in view of Faria discloses an o-ring (Cox, #19; Faria, #60) at the second end of the filter element but does not disclose another o-ring at the other end. Tettman teaches an oil filter comprising an o-ring (Fig. 4, #44) at the other end of the filter element against a bottom surface of the can-like body. It would have been obvious to one of ordinary skill in the art to modify Cox in view of Faria with the element of Tettman in order to prevent liquid from traveling through the housing without passing through the filter media (Col. 2, Lines 58-60).

6. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Faria as applied to Claims 8 and 19 above, and further in view of Smith et al., U.S. Patent No. 5,569,373.

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Regarding Claims 18 and 20, Cox in view of Faria does not disclose an insert fitting. Smith teaches a reusable oil filter comprising an internally and externally threaded insert fitting (#16). It would have been obvious to one of ordinary skill in the art to modify Cox in view of Faria with the element of Smith in order to allow the filter to be adapted to a wide variety of engines produced by various manufactures (Col. 3, Lines 11-17).

7. Claims 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Faria as applied to Claims 17 and 19 above, and further in view of Goddard, U.S. Patent No. 6,068,763.

Regarding Claims 28 and 31, Cox in view of Faria does not disclose feet. Goddard teaches an oil filter comprising a bypass valve (#60) spaced away from the can-like body (#14) by a plurality of feet (#92). It would have been obvious to one of ordinary skill in the art to modify Cox in view of Faria with the element of Goddard in order to permit flow of fluid through the bypass valve in the event of an excessive pressure differential across the filter element (Col. 7, Lines 48-54).

8. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Faria and Smith as applied to Claim 28 above, and further in view of Oohashi et al., Pub. No. US 2003/0106848 A1.

Regarding Claim 29, Cox discloses an o-ring sealing a second end of the tubular woven element against the inner surface of the cap (Col. 3, Lines 40-44) but does not disclose another o-ring sealing against the bypass valve. Oohashi teaches an oil filter comprising an o-ring (#15) sealing the first end of the filter element (#5) against the member (#16) on which the bypass valve (#10) is mounted. It would have been obvious to one of ordinary skill in the art to modify

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Cox in view of Faria and Smithe with the element of Oohashi because it is a sealing means common in the filter art.

9. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Faria as applied to Claim 19 above, and further in view of Oohashi.

Regarding Claim 32, Cox discloses an o-ring sealing a second end of the tubular woven element against the inner surface of the cap (Col. 3, Lines 40-44) but does not disclose another o-ring sealing against the bypass valve. Oohashi teaches an oil filter comprising an o-ring (#15) sealing the first end of the filter element (#5) against the member (#16) on which the bypass valve (#10) is mounted. It would have been obvious to one of ordinary skill in the art to modify Cox in view of Faria and Smithe with the element of Oohashi because it is a sealing means common in the filter art.

Response to Arguments

10. Applicant's arguments filed on March 17, 2006 have been fully considered but they are not persuasive.

Regarding the arguments, Faria does disclose a reusable oil filter comprising annular arc segment openings. The openings (#48) together form an annular arc shape and individually are segments of the arc. Since the width of the openings (#48) is larger than the distance between the openings, they do occupy most of the annular area.

Therefore, Cox in view of Faria teaches the invention as claimed.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yoon-Young Kim whose telephone number is (571) 272-2240. The examiner can normally be reached on 8:30-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YK
05/24/06



TERRY K. CECIL
PRIMARY EXAMINER